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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,609	11/09/2001	Ruediger Stenzel	016790-0443	5951

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Washington, DC 20007-5109

EXAMINER
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NGUYEN, THONG Q

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/986,609

Applicant(s)

STENZEL, RUEDIGER

Examiner

Thong Q. Nguyen

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☒ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

**DETAILED ACTION**

***Response to Amendment***

1. The present Office action is made in response to the Pre-amendment filed by applicant on 11/09/2001.

***Priority***

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on 11/09/2000. It is noted, however, that applicant has not filed a certified copy of the Germany application as required by 35 U.S.C. 119(b).

***Drawings***

3. The drawings contain two (02) sheets of figures 1-2 were received on 11/09/2001. These drawings are objected by the Examiner for the following reasons.
4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, each of the following features: a) the feature relating to the use of a single transponder for a plurality of objectives as recited in the feature thereof "one transponder (6) each is associated with the objective (2) or objectives (2)" (claim 1, lines 6-7); b) the feature relating to the arrangement of one single transponder on a plurality of lens barrels of the objectives as recited in claim 2; c) the feature relating to a common housing for the transponder and the antenna as recited in claim 10; d) the feature relating to an excitation coil for activation the transponder as recited in claim 13; e) the feature relating to the arrangement of the reading device on the stand as recited in each of claims 14 and 17;

and f) the feature relating to the filter systems as recited in claim 23 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

6. The disclosure is objected to because of the following informalities: a) The summary of the invention is objected to because it refers to the claim(s) and it contains numerous details of the inventive device. Applicant is suggested to provide a brief technical summary of the inventive device, and provides the detailed information/description of the inventive device to the section of "Detailed description of the Invention" b) The Brief description of the drawing is also objected to because it refers to the claim(s). There is still some grammatical and idiomatic errors in the specification. Applicant should carefully proofread the specification. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 1 is rejected under 35 USC 112, second paragraph for the following reasons: a(1)) The structure and/or arrangement of a single transponder with the objective or objectives as recited in the feature thereof "one transponder (6) each is associated with the objective (2) or objectives (2)" (claim 1, lines 6-7) is unclear. While the arrangement of one transponder with one particular objective is known and clear to one skilled in the art; however, it is unclear to one skilled in the art about the structural relationships among a single transponder and a plurality of objective lenses as claimed.

a(2)) The claim is also indefinite because it is unclear about the structure between the reading device and the stand. As stated in the specification, the reading device is mounted/formed on the revolving nosepiece and the nosepiece is rotatably mounted to the stand. As such, it is unclear about the structural relationship between the reading and the stand as claimed in the feature thereof "a reading device... the stand".

b) The mentioned problem relating to the arrangement of one transponder and plural objectives is further questioned when the claims 2 and 3 claims that the single transponder is arranged on the barrels or the baffle plate of plural objectives.

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c) Regarding claim 4, the phrase "preferably" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

d) Each of claims 14 and 17 is rejected under 35 USC 112, second paragraph for the similar reason as set forth in element a(2) above.

e) Claim 18 recites the limitation "the optical axis" in the feature thereof "the read...optical axis" (lines 1-2). There is insufficient antecedent basis for this limitation in the claim.

f) Claim 21 is indefinite because the feature thereof "the particular objective" (line 2) lacks a proper antecedent basis.

g) Claim 22 is indefinite because each of the features thereof "the degree of correction of the objective or objectives" (lines 1-2); "the equalization length" (line 2) and "the color profile" (lines 2-3) lacks a proper antecedent basis.

h) Claim 23 is indefinite because the feature thereof "the wavelength and/or line width of filters or filter systems" (lines 1-2) lacks a proper antecedent basis.

i) The remaining claims are dependent upon the rejected base claim and thus inherit the deficiencies thereof.

***Allowable Subject Matter***

9. Claims 1-24 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

10. The following is an examiner's statement of reasons for allowance:

The device as claimed in claim 1 is patentable with respect to the cited art, in particular, the U.S. Patent Nos. 4,555,620; 4,531,816 and 4,544,236 by the use of a detecting system for detecting a particular objective lens in the optical path of a microscope having a turret supporting a plurality of objective lenses wherein the detecting system comprises a transponder and a reading element. While the use of a detecting system for detecting a particular objective lens in a microscope is well known to one skilled in the art, and the use of a transponder and a reading element is known such as those use to permit a driver pass his/her automobile through a gate in a garage or parking area; however, the prior art of the microscope just disclose the use of ultrasonic elements or magnetic elements or photointerrupter. The prior art does not disclose the use of a detecting system having a transponder and a reading element both attached/mounted on the turret supporting a plurality of objective lenses of a microscope.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references are cited as of interest in that each discloses a microscope having a revolving/turret supporting a plurality of objective lens and a

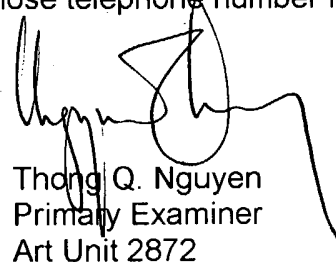
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detecting system for detecting a particular objective lens in the optical path of the microscope.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (703) 308-4814. **Note that after Jan. 20, 2004, the Examiner may be reached at his new telephonic number of 571-272-2316.** The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on (703) 305-0024. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0956.



Thong Q. Nguyen  
Primary Examiner  
Art Unit 2872

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